

### **REMARKS**

This communication is filed in response to the Office Action mailed on December 8, 2005. No claims are amended, claims 1-7, 47, and 49 are canceled, and no claims have been added. As a result, claims 8-46, 48, and 50-65 remain pending in this Application, of which claims 8-19, 21-46, 48, and 50-64 are withdrawn.

#### **Claims 28-30, 34-38, 43-46, 48, and 65 Withdrawn**

It is noted that claims 28-30, 34-38, 43-46, 48, and 65 have been withdrawn because the Office asserts that the limitation “complementary shape” would not read on Figure 15. The Applicant respectfully traverses, noting that if “the limitations do read on FIG. 5,” as asserted by the Office, then there is no reason why the same limitations could not also read on FIG. 15, and thus, the withdrawn claims are not directed to non-elected subject matter. This is because it is specifically stated in the application that “Figure 5 is a top plan (or side cut-away) view” of an embodiment, whereas “Figure 15 is a top, plan view”. Application, pg. 6, line 24 and pg. 7, line 20. Further, “[r]eferring back to Figures 4-10, which have heretofore been described as top, plan views of the invention (using the “X” and “Y” directions to define a substantially horizontal, planar coordinate system in which the conductive layers of the circuit are disposed), it should also be understood that Figures 4-10 can be alternatively be considered as side, cut-away views of the invention (using the “Z” direction to define a vertical dimension, or depth, which is substantially perpendicular to the horizontal X-Y plane in which the circuit board lays).” Application, pg. 15, lines 22-28. Thus, FIG. 15 may indeed read on some or all of the claims withdrawn by the Office.

#### **§102 Rejection of the Claims**

Claim 20 was rejected under 35 USC § 102(b) as being anticipated by Kumagai et al. (U.S. Patent No. 6,147,573, hereinafter “Kumagai”). First, the Applicant does not admit that Kumagai is prior art, and reserves the right to swear behind this reference in the future. Second, because Kumagai does not disclose the identical invention as claimed, the Applicant respectfully traverses this rejection.

Kumagai teaches a multilayer electronic body 24 to be mounted to a printed circuit board 9. *See* Kumagai, FIG. 1D and Col. 4, lines 5-7. The body 24 is made from coil conductors 2 formed on green sheets 1 and connected to each other using through-holes 3 to form a coil 40. *See* Kumagai, FIGs. 1A, 1C; and Col. 4, lines 13-21, and 52-55. In FIG. 3B, cited by the Office, terminal electrodes 20 are connected to each end of the coil 40 with leading conductors 29. *See* Kumagai at FIGs. 1C and 3B; Col. 4, lines 52-55; and Col. 6, lines 26-34. In FIG. 3C, cited by the Office, Kumagai teaches forming a capacitor 28 connected to the coil 40 using a leading conductor 29. *See* Kumagai, Col. 7, line 64 – Col. 8, line 1.

It is asserted in the Office Action that Kumagai's conductors 29 (see FIGs. 3B and 3C) are the same as the interstices 150, 160 (See Application, FIG. 4A) claimed by the Applicant in claim 20. However, a close reading of Kumagai reveals that such is not the case.

Independent claim 20 includes the following limitation: "a second conductive layer including a second interstice engaged with the first interstice". Thus, the first and second interstices are *engaged* (see Application, Figure 4A, elements 150, 160). To be "engaged" means "meshed," which in turn, means "interlocked." *See Webster's Ninth New Collegiate Dictionary*, G. & C. Merriam Company, pgs. 412 and 744, 1983. In other words, if one were to attempt to "pull" the conductive layers 110, 120 apart in the  $\pm Y$  direction in Application Figure 4A, for example, the engaged interstices 150, 160 would prevent such separation. However, this cannot be said about the conductors 29 of Kumagai. These conductors 29, which simply serve to connect each end of the coil 40 with respective electrodes 20, are not engaged in any sense of the word. *See* Kumagai, Col. 4, lines 50-55, and FIGs. 3B, 3C.

Moreover, the body 24 and conductors 29 do not provide "a first conductive layer including a first interstice, wherein the first interstice has a plurality widths laying in a first plane ... a second conductive layer including a second interstice ... wherein the second interstice has a single second width laying in a second plane ... and a dielectric layer disposed between the first and second interstices to form a capacitor, wherein the first and second planes are substantially parallel, and wherein the second width substantially overlaps at least two of the plurality of widths" as claimed by the Applicant, and recited in the Office Action.

It is respectfully noted that anticipation under 35 USC § 102 requires the disclosure in a single prior art reference of each element of the claim under consideration. *See Verdegaaal Bros.*

*V. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987). It is not enough, however, that the prior art reference discloses all the claimed elements in isolation. Rather, “[a]nticipation requires the presence in a single prior reference disclosure of each and every element of the claimed invention, *arranged as in the claim.*” *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)) (emphasis added). “The *identical invention* must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989); MPEP § 2131 (emphasis added).

In addition, while claims during examination should be interpreted as broadly as their terms reasonably allow, that interpretation must be tempered by the context in which the terms are used. The *Hyatt* court states that “during examination proceedings, claims are given their broadest reasonable interpretation consistent with the specification.” *In re Hyatt*, 211 F.3d 1367, 1372, 54 U.S.P.Q.2D (BNA) 1664, 1667 (Fed. Cir. 2000) (emphasis added) (“During examination proceedings, claims are given their broadest reasonable interpretation consistent with the specification.”; citing *In re Graves*, 69 F.3d 1147, 1152, 36 U.S.P.Q.2D (BNA) 1697, 1701 (Fed. Cir. 1995); *In re Etter*, 756 F.2d 852, 858, 225 U.S.P.Q. (BNA) 1, 5 (Fed. Cir. 1985) (en banc).).

The interpretation of the term “interstice” and “plurality of first widths” proffered by the Office is neither reasonable, nor consistent with the specification. It is not reasonable because it does not encompass the meaning of the word as understood by those of skill in the art, and confirmed by the dictionary, above. It is not consistent with the specification because it is apparent from viewing FIGs. 4A and 14 of the Application that the relationship between the Applicant’s interstices 150, 160 and widths W3, W4 are not what is asserted by the Office. See Application, pg. 17, line 27 – pg. 18, line 18. Thus, characterizing Kumagai’s conductors 29 as “interstices,” or asserting that these conductors 29 have a “plurality of widths laying in a first plane” (as shown in FIG. 14 of the Application) is beyond that which should be reasonably allowed.

Since Kumagai does not teach interstices that engage, nor interstices that have a plurality of widths, what is disclosed by Kumagai is not identical to the subject matter of the embodiment claimed, and thus, the rejection of claim 20 under § 102 is improper. Reconsideration and allowance are respectfully requested.

### CONCLUSION

The Applicant respectfully submits that all of the pending claims are in condition for allowance and notification to that effect is earnestly requested. **As noted above, if the Examiner is not convinced that all of the pending claims are in condition for allowance after reviewing this document, the courtesy of an Examiner's Interview is respectfully requested prior to preparing and mailing any Final Office Action.**

The Examiner is invited to telephone the Applicant's attorney Mark Muller at (210) 308-5677, or the undersigned attorney to facilitate prosecution of this Application. If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

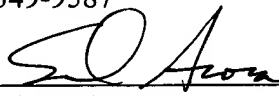
Respectfully submitted,

STEVE VAN KIRK


By his Representatives,

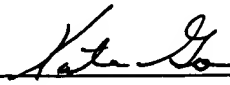
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Date February 28, 2006

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